

REMARKS

Claims 1-11 have been rejected on prior art grounds. Claim 11 is hereby canceled without prejudice or disclaimer. Hence, claims 1-10 are all the claims pending in the application.

Claim Rejections - 35 U.S.C. § 101

The Examiner has maintained the rejection of claim 6 under 35 U.S.C. § 101 as allegedly being directed to non-statutory matter. Claim 6 is amended to recite a computer readable storage medium. It is respectfully submitted that the claims comply with 35 U.S.C. § 101. Thus, Applicants respectfully request withdrawal of the rejection.

Claim Rejections - 35 U.S.C. § 103(a)

The Examiner has maintained the rejection of claims 1, 2, 6-8, 10, and 11 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Thomas Hedberg et al, "Evolving WCDMA", ERICSSON REVIEW, 'Online! No. 3, 2001, pp. 124-131, XP002228837 (hereinafter "Hedberg") in view of Hiramatsu et al., "Transmit Diversity Applied on the CDMA/TDD Cellular System" IEEE Publication, May 15-18, 2000 (hereinafter "Hiramatsu"). Applicants submit that the claims are patentable.

For example, claim 1 recites sending one of the first signals to one of the plurality of user equipments on one of the dedicated channels on a carrier frequency by applying transmit diversity and *simultaneously* sending one of the second signals on the code-multiplexed shared channel on the carrier frequency by applying multi-user diversity through the assigned antenna.

Applicants submit that Hedberg and Hiramatsu, alone or in combination, do not teach or suggest sending the first and second signals *simultaneously*. On page 7 of the Office Action, the Examiner acknowledges that this feature is not taught, but alleges that it would have been obvious "that the method as modified would simultaneously communicate with users on assigned

channels.” The Examiner further asserts that “the claimed concept of simultaneous communicating with users is well known to one skilled in the art at the time the invention was made.” Applicants submit that the Examiner has failed to establish a prima facie case of obviousness at least for the following reasons.

First, Applicants note that the claim does not simply recite “simultaneously communicating with users on assigned channels,” as asserted by the Examiner. Instead, the claim recites sending one of the first signals to one of the plurality of user equipments on one of the dedicated channels on a carrier frequency by applying transmit diversity and simultaneously sending one of the second signals on the code-multiplexed shared channel on the carrier frequency by applying multi-user diversity through the assigned antenna. The combination of Hedberg and Hiramatsu is silent about simultaneously transmitting two different channels on a same carrier frequency by applying transmit diversity and multi-user diversity.

Moreover, the mere conclusory statement that simultaneous communication is well known, is not enough to establish a prima facie case of obviousness. The characterization of certain limitations or parameters as obvious does not make the claimed invention, *considered as a whole*, obvious. It is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Applicants submit that pg. 126 of Hedberg teaches the use of open-loop transmit diversity as an enhancement *within the 3GPP standard, not in a system using the HS-DSCH*. Hedberg teaches that transmit diversity enhances capacity and coverage in the context of the existing release of the (pre-HS-DSCH) 3GPP standard. Therefore, the Examiner’s proffered motivation is unsupported by the reference.

Applicants also submit that the Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the Examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness. See MPEP 2142. In the absence of evidence which suggests the desirability of combining references in a proposed manner, such combination is not available to preclude patentability under 35 U.S.C. § 103. See King Instrument Corp. v. Otari Corp., 226 U.S.P.Q. 402 (Fed. Cir. 1985). The reason for this principle is that unless the Examiner goes beyond mere assertions and provides evidence, the Applicant will not have the opportunity to rebut the Examiner.

In view of the foregoing, Applicants submit that claim 1 is not rendered unpatentable by Hedberg and Hiramatsu.

Independent claims 6, 7, and 10 recite features similar to those discussed above in conjunction with claim 1. Accordingly, Applicants submit that these claims are patentable at least for reasons analogous to those discussed above regarding claim 1. Applicants also submit that claims 2 and 8, being dependent on one of claims 1 and 7, are patentable at least by virtue of their dependency.

Claims 3, 4, 5 and 9 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Hedberg in view of Hiramatsu and further in view of Dahlman et al. (U.S. Patent Application 2002/0145988; hereinafter "Dahlman"). Each of these claims depends from one of claim 1 and claim 7, both of which have been shown above to be patentable over the Hedberg and Hiramatsu combination. Dahlman does not cure the deficiencies of Hedberg and Hiramatsu discussed above. Thus, Applicants submit that the claims are patentable at least by virtue of their dependency.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

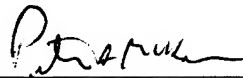
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